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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VU, THONG H

ART UNIT PAPER NUMBER

2152

DATE MAILED: 12/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

2152

Office Action Summary

Application No.

08/992,770

Applicant(s)

Hachiya et al

Examiner

Thong Vu

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 5, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 49, 51-70, 93-106, 113-117, and 121-125 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 49, 51-70, 93-106, 113-117, and 121-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

1. This office action is in response to Request for Reconsideration filed 10/05/2001. Claims 1-24,49,51-70,93-106,113-117,121-124 and new claim 125 are pending. The rejections cited are as stated below.

2. Applicant elects Group I from restriction, including claims 1-24,49,51-70,93-106,113-117 and 121-124. The remaining claims are canceled without prejudice.

Double Patenting

3. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A Claims 1-24,49,51-70,93-106,113-117,121-125 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-12** of U.S. Patent No. **6,311,195 B1** ['195]

As per claims 1-24,49,51-70,93-106,113-117,121-125, the applicant's invention discloses "a method for automatic control E-mail including a plurality of agent parameters, delivering an E-mail appended to main mail text having an appended mail header, a pre-set illustrative sentence; updating (or modifying) the agent parameters, control the behavior of the agent; automatically returning an indication"

which are equivalent to a method for sending E-mail with agent parameters; sending command for commanding sending of E-mail; based on pre-set time; the main text of the mail having an appended mail header; automatically returned from the destination; controlled by said agent manager for appending the agent parameters determining the behavior of the agent to the mail header ['195, col 21 lines 24-64].

B Claims 1-24,49,51-70,93-106,113-117,121-125 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-6** of U.S. Patent No. **6,175,857 B1** ['857]

As per claims 1-24,49,51-70,93-106,113-117,121-125, the applicant's invention discloses "a method for automatic control E-mail including a plurality of agent parameters, delivering an E-mail appended to main mail text having an appended mail header, a pre-set illustrative sentence; updating (or modifying) the agent parameters, control the behavior of the agent; automatically returning an indication"

which are equivalent to a method for extracting E-mail header with agent parameters; controlling the behavior of an agent, the specified agent parameter is increased or decreased in magnitude when it is returned to the sender of the E-mail; the main text of the mail having an appended mail header; processing the specified agent parameter to return the parameter to a sender of the E-mail ['857, col 24 lines 20-65].

C Claims 1-24,49,51-70,93-106,113-117,121-125 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-15** of U.S. Patent No. **6,199,097 B1** ['097]

As per claims 1-24,49,51-70,93-106,113-117,121-125, the applicant's invention discloses "a method for automatic control E-mail including a plurality of

agent parameters, delivering an E-mail appended to main mail text having an appended mail header, a pre-set illustrative sentence; updating (or modifying) the agent parameters, control the behavior of the agent; automatically returning an indication”

which are equivalent to a method for extracting E-mail header and agent parameters; said predetermined mail header indicative of a common event of said plurality of agents; a computer-readable data collection program adapted for performing control of receiving a plurality of E-mails; generating the ranks of the agents based on the collected results of the agent parameters; [’097, col 23 line 60- col 24 line 65].

Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the cited claims of the U.S. patent.

Claim Objections- 37 C.F.R. 1.75(a)

4. Claims 99, 116, and 123 are objected to under 37 C.F.R. 1.75(a) as failing to describe what the inventor specifically regards as his invention, because of the following informalities: The claims are generally narrative, vague and ambiguity, failing to conform with current U.S. practice. Appropriate correction is required. Examiner suggests the applicant amends the claims language by narrow the scope of the claims which could result to patentable merit.

5. Claim 53 contains an indefinite limitation (e.g. a predetermined life span). Correction is required.

6. Claims 1-24,49,51-70,93-106,113-117 and 121-125 are rejected under 35 U.S.C. 103 as being unpatentable over Li et al [6,067,568] in view of Okada [6,101,548].

7. As per claims 1,58,68,70,99,105,107,116-117,123-125 Li discloses a method for automatic control of the transmission of an E-mail, wherein a plurality of agent parameters controlling the behavior of an agent delivering an E-mail are appended to the main mail text having an appended mail header (or changing e-mail parameters), the agent parameters are responsive to a send command designating the transmission of the E-mail for transmission to a

recipient [Li Fig 5, col 8 line 52-col 9 line 10];

wherein the agent parameters are modified responsive to the contents of experiences reflecting the operating hysteresis for the agent [Li col 9 lines 46-col 10 line 10]; and further

wherein an E-mail of a pre-set illustrative sentence is sent by said agent to a user of the agent based on said agent parameters [Li Fig 5].

Li also discloses the header information [Li col 6 lines 65] the parameter and setting for particular service [Li col 6 lines 40-45], a mail agent for managing an e-mail service [Li col 8 line 45] and Internet service [Li col 4 lines 10-20].

However Li is silent on the e-mail are appended to the main mail text having and appended mail header. A skilled artisan would have looked to the Electronic Messaging art to improve the Li's system and found the Okada's teaching. Okada discloses an electronic mail system wherein email format is edited by appending mail header [Okada col 4 lines 18-30].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the appended email header as taught by Okada into the Li's system in order to improve the automatic sending email process by controlling the header information. By doing so would utilize the email with the changing electronic mail parameters (or appended the main text) by using an appended header to provide the quick, simple and reliable process on email service on the network.

Thus, the system and method of claims 1,58,68,70,99,105,107,116-117,123-125 is obvious in view of the combination of references.

8. As per claims 49,67,69 Li-Okada disclose A method of controlling a virtual agent, comprising the steps of:

generating a virtual agent adapted to deliver E-mails and having a plurality of agent parameters, said agent parameters configured to determine a behavior of said virtual agent [Li col 9 lines 46-col 10 line 10];

displaying said virtual agent on a display unit [Li Fig 5];

interacting with said virtual agent on said display unit, including positioning at least a portion of a display of an input device over said virtual agent on said display unit, detecting an input signal from said input device, and modifying the agent parameters such that said displaying step displays said virtual agent in response to said input signal [Li col 9 lines 46-col 10 line 10]; and updating said plurality of agent parameters based on said interacting step such that the behavior of said virtual agent is continuously modified such as in mail editing the converted data is edited to e-mail format by appending mail header information [Okada col 4 lines 18-30].

9. As per claims 113,114,121 Li-Okada disclose a method of providing a virtual agent, said method comprising the steps of:

sending a first agent parameter at a first computer operated by a first person to a second computer remote from said first computer using E-mail through a communication network, wherein said second computer is operated by a second person and said first agent parameter controls a first agent kept by said first person [Li Fig 5-7];

receiving said first agent parameter sent from said second computer at said first computer; receiving a second agent parameter sent from said second computer at said first computer, said second agent parameter controlling a second virtual agent kept by said second person [Okada col 4 lines 18-30]; and

sending said received second agent parameter to said second computer using said first

computer [Li col 2 line 39-col 3 line 17].

10. As per claims 93,115,122 Li-Okada disclose a method of providing a virtual agent, said method comprising the steps of:

detecting one or more events corresponding to a first virtual agent adapted to deliver E-mail, wherein the behavior of said first virtual agent is determined by a plurality of first agent parameters such as detecting the appending main text based on the appended mail header [Okada col 4 lines 18-30];

updating said plurality of first agent parameters based on a current first agent parameter with each detected event such that the behavior of said first virtual agent is continuously modified with each detected event [Okada col 4 lines 18-30]; and

wherein said events include an interaction between said first virtual agent and a second virtual agent controlled by a second agent parameter and an interaction between said first virtual agent and an operation by an operator [Li col 9 lines 46-col 10 line 10].

Thus, the system and method of claims 49,67,69;93,115,122;113,114,121 is obvious in view of the combination of references.

11. As per claim 2, Li-Okada disclose a control procedure is performed so that an illustrative sentence of an E-mail for transmission is randomly selected from a plurality of illustrative sentences classed and pre-set depending on the contents of experiences acquired by said agent so that the selected sentence is in a class consistent with the contents of experiences acquired by said agent, the selected sentence being voluntarily sent to the user of the agent as inherent feature of virtual agent or icon [Li col 9 line 24-col 10 line 30].

12. As per claim 3, Li-Okada disclose an effective period of said agent is set and an E-mail is

voluntarily sent to the user of said accent upon expiration of said effective period as inherent feature of set of rules [Li col 5 lines 30-50].

13. As per claims 4-24 contain the similar limitations set forth of method claims 1-3.

Therefore, claims 4-24 are rejected for the same rationale set forth claims 1-3.

14. As per claims 51,52,57,61,104, Li-Okada disclose said input signal includes one of petting said virtual agent; and said first agent is an animated character (or 3D image, icon).

Examiner takes an Official Notice that the virtual agent or an animated icons are well-known in the art [see Bimbo et al and Thalmann et al references].

15. As per claims 53, 62-64 Li-Okada disclose the predetermined life span of said agent is two year and expired is a design choice.

16. As per claims 54,55 Li-Okada disclose said virtual agent is capable of generating one or more messages based on the updated agent parameters responsive to state of said virtual agent as a design choice.

17. As per claims 94,97 Li-Okada disclose said first parameter is sent from said first memory device to a remote computer through Internet [Li col 4 lines 10-20].

18. As per claims 56,98-100-103,106, Li-Okada disclose randomly generating said first agent parameter [Li Fig 2, col 4 lines 40-47]; sending said agent parameter through a communication network using an E-mail; updating, receiving, displaying, modifying said agent parameter as inherent feature of sending email through virtual agent [Li col 9 lines 46-col 10 line 10].

19. As per claim 59, Li-Okada disclose said agent parameters are continuously updated based on the interaction of said agent such that the behavior of said agent is continuously modified [Li col 8 line 29-col 9 line 10].

20. As per claim 60, Li-Okada disclose transmitting said email via a mail server [Li col 5 line 57-col 6 line 11]; and expiration period for purging email which is inherent feature of mail server and well-known in the art.

21. As per claims 65-66, Li-Okada disclose the displaying and selecting the predetermined messages by agent as inherent feature of virtual agent [Li Fig 5].

Thus, as explained above, the system and method of claims 1-24,49,51-70,93-106,113-117 and 121-125 is obvious in view of the prior art.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Mark Rinehart*, can be reached at (703) 305-4815.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

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